

NEIFELD IP LAW, P.C.
4813-B Eisenhower Avenue
Alexandria, Virginia 22304

ZFW
AF
Tel: 703-415-0012
Fax: 703-415-0013
Email: rneifeld@Neifeld.com
Web: www.Neifeld.com



37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Neifeld Docket No.: PIP-69B-KATZ
US/PCT Application/Patent No.: 09/828,122
Priority Data:
Inventor: Gary M. KATZ
Title: Paired Promotion Architecture

Client Ref.:
US/PCT File/Issue Date: 4/9/2001
USPTO Confirmation No.: 5972

THE FOLLOWING HAS BEEN RECEIVED IN THE U.S. PATENT OFFICE ON THE DATE STAMPED HEREON:

37 CFR 1.7(c) Filing Receipt and Transmittal Letter with Authorization to Charge Deposit Account (in
duplicate)
37 CFR 1.143 Response to Election of Species Requirement

The Commissioner is hereby authorized to charge any fees which may be required, or
credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet
is enclosed.

4/4/06
DATE

Respectfully Submitted,

Richard A. Neifeld
Registration No. 35,299
Attorney of Record

Fees:	PcLaw Matter	Lawyer	Amount	Explanation	Date Entered	Initials
Fees:						
Disbursements:	PcLaw Matter	G/L Account	Amount	Explanation	Date Entered	Initials
			5010			



NEIFELD DOCKET NO: PIP-69B-KATZ

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

APPLICATION NO.: 09/828,122

CONFIRMATION NO.: 5972

IN RE APPLICATION OF: Gary M. KATZ

FILED: 4/9/2001

GROUP ART UNIT: 3622

EXAMINER: RETTA

FOR: Paid Promotion Architecture

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

37 CFR 1.143 RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Sir: In response to the office action mailed March 27, 2006, please enter the following response.

I. The Office Action

The cover page of the office action dated March 27, 2006 indicates that claims 1-64 are pending in the application. Claims 1-64 are subject to restriction. The body of the office action states that:

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-58, drawn to pairing a first low relevance promotion with a second more relevant promotion, classified in class 705, subclass 14.
- II. Claims 59-64, drawn to determining a first product, from a first product category or from a first product in a product category, that has not been purchased before by a consumer and determining a second product from a second category that has been purchased before and printing on a single sheet of paper the first promotion to purchase a product from a product item in the first category and a second promotion to purchase a product item from the second category classified in class 705, subclass 14.

Newly submitted claims 59-64 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim recites determining a promotion for a product which has never been purchased and pairing it with a promotion for a product that has been purchased before, by the same consumer.

Examiner considers that since applicant independently claim the invention of this group, it is *prima facie* showing that the inventions are intended to be independently and distinct and are shown to be separately usable.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59-64 are withdrawn from consideration as being directed to a non-elected invention. See

37 CFR 1.142(b) and MPEP Section 821.03. [Office action mailed 3/27/2006 page 2 line 16 through page 3 line 15.]

II. Response with Provisional Election and Traverse

In response, the applicant provisionally elects Subcombination I., claims 1-58 with traverse. The applicants traverse because the requirement for restriction does not comply with authority binding upon the examiner for the many reasons noted below.

The MPEP is binding upon the examiner insofar as it is the procedural requirements imposed on the examiner by the Director. Therefore, a requirement for restriction that fails to comply with the MPEP is improper and should be withdrawn. Cf. In re Portola, 110 F.2d 786, 788, 42 USPQ2d 1295 (Fed. Cir. 1997).

III. Comparison of MPEP Requirements to the Examiner's Basis for Restriction

A. MPEP 808

MPEP 808 states:

808 Reasons for Insisting Upon Restriction

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections.

The examiner has not presented any reason why the inventions as claimed are either independent or distinct. The examiner has only presented the following statement:

[Claims 59-64 recite] determining a promotion for a product which has never been purchased and pairing it with a promotion for a product that has been purchased before, by the same consumer. [Office action mailed March 27, 2006 page 3 lines 6-8.]

The examiner's statement summarizes certain limitations in Group II. However, it has no relevance to this requirement for restriction without a discussion as to why Group I and Group II are independent and distinct.

Moreover, in the office action mailed March 27, 2006 page 3 lines 9-11 with interpolation provided, the examiner states that:

Examiner considers that since applicant independently claim [sic] the invention of this group, it is *prima facie* showing that the inventions are intended to be independently and distinct and are shown to be separately usable.

This conclusion by the examiner has no basis. Furthermore, the examiner is making a conclusion as to the applicant's intention. The applicant points out that by adding new claims 59-64 as an amendment rather than filing an additional application, the applicant intends Group II to be the same invention as Group I.

For the reasons presented above, the examiner has not presented a tenable reason for insisting upon restriction as specified in MPEP 808. Therefore, the requirement for restriction is improper and should be withdrawn.

B. MPEP 816

MPEP 816 states, with emphasis supplied:

816 Give Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or

she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the reasons for the conclusions of distinctness of invention as claimed set forth.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See MPEP § 809.

The examiner has provided no reasons for a holding of independence or distinctness. The examiner has only presented a mere statement of conclusion, an assertion that MPEP 816 expressly describes as "inadequate." Furthermore, the examiner has not presented a tenable reason for insisting upon restriction as specified in MPEP 816. Therefore, the requirement for restriction is improper and should be withdrawn.

C. MPEP 803

MPEP 803 states the burden on the examiner for a search and examination of an entire application:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The examiner indicated that the two groups are classified in the same class and subclass and did not assert that the two groups have obtained a separate status in the art. The examiner has not shown that examining this application imposes a serious examination burden. Therefore, the applicant assert that the requirement for restriction is improper and should be withdrawn.

IV. The Examiner's Unilateral Withdrawal of Claims 59-64 is Improper

The examiner has attempted to unilaterally withdraw claims 59-64, stating in the office action mailed March 27, 2006 at page 3 lines 12-15 that:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59-64 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP Section 821.03.

37 CFR 1.142(b) states:

Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

MPEP 821.03 states:

Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145 states:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

In response, the applicant has provisionally elected Subcombination I., claims 1-58 with traverse. Therefore, the examiner's improper and unilateral withdrawal of claims 59-64 is moot.

V. The Serious Burden Placed Upon the Applicant by the Requirement

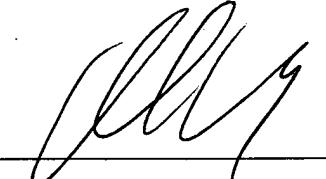
The applicants request that the examiner keep in mind the serious (and often unnecessary) financial burden placed upon *the applicants* in having to split prosecution between division applications in response to a requirement for restriction. Accordingly, the applicants request that the examiner withdraw the requirement for restriction.

VI. Closure

Should Examiner Retta have any questions, the examiner is urged to contact the undersigned at (703) 415-0012.

Respectfully Submitted,

4/4/06
Date


Richard A. Neifeld, Ph.D.

Registration No. 35,299
Attorney of Record

BTM

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